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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,705	10/12/2005	Janne Parantainen	915-001.053	2037

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WARE FRESSOLA VAN DER SLUYS & ADOLPHSON, LLP  
BRADFORD GREEN, BUILDING 5  
755 MAIN STREET, P O BOX 224  
MONROE, CT 06468

EXAMINER
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STEPHEN, EMEM O

ART UNIT	PAPER NUMBER
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2617

MAIL DATE	DELIVERY MODE
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12/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/529,705	<b>Applicant(s)</b> PARANTAINEN, JANNE	
	<b>Examiner</b> EMEM STEPHEN	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-14, 23-29, 33-46, and 51-54 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,600,917 B1 to Maupin.

Regarding claims 1, 23, 33, and 51, Maupin discloses a terminal, a network element, a system and a method for indicating one or more terminal capability requirements for point-to-multipoint MBMS service reception in a wireless system (see fig. 6), characterized in that said method comprises the step of transmitting a broadcast or multicast message indicating said terminal capability requirements over the air interface to at least one terminal within the service range in order to allow the terminal to determine whether it is capable of receiving the service or not (see fig 6 steps 1-4, col. 2 line 64-col. 3 line 20, col. 6 lines 12-19, col. 8 line 36-col. 9 line 8), said requirements being indicated in relation to at least one of the following: time slot configuration, modulation type, bit rate, and capability class (col. 1 lines 34-55, col. 2 lines 57-61, radio access technology type and generation).

Regarding claim 2, Maupin discloses the method of claim 1, characterized in that a decision of whether to receive the service or not is made in the terminal on the basis of said indication (col. 8 line 47-col. 9 line 8).

Regarding claim 3, Maupin discloses the method of claim 1, characterized in that it further comprises a step wherein said requirements for receiving the service are defined (col. 8 line 60-col. 9 line 3).

Regarding claim 4, Maupin discloses the method of claim 1, characterized in that it further comprises a step wherein the service-related data is transmitted in conformity with indicated requirements (col.9 lines 8-55).

Regarding claims 5, and 24, Maupin discloses the method of claim 1, characterized in that said requirements are indicated in said message implicitly with an identifier associated to a certain set of requirements (see fig. 5).

Regarding claims 6, 25, 37-38, and 53, Maupin discloses characterized in that said requirements are indicated in said message explicitly with parameters (see figs. 4-5).

Regarding claims 7-11, 27, 29, and 39-41, Maupin discloses characterized in that said system is substantially GSM /GPRS or UMTS system (see fig. 1).

Regarding claims 12-14, 26, 28, 34, 42-46, and 52, Maupin discloses characterized in that said message is substantially a schedule message, characterized in that said schedule message is CBS service specific (col. 2 lines 64-67).

Regarding claims 36, and 54, Maupin discloses characterized in that said network element further comprises means for receiving said requirements for point-to-multipoint service reception prior to sending said message indicating said requirements (col. 4 lines 54-63, and col. 6 lines 17-19).

3. Claims 15-16, 19-20, 30, and 47-48 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 6006091 to Lupien.

Regarding claims 15, 30, and 47, Lupien discloses a terminal, a network element, and a method for indicating requirements for point-to-multipoint MBMS service reception in a wireless system to be performed by a terminal operable in said system (see fig. 1, and col. 5 lines 30-42), characterized in that said method comprises the step of informing the terminal's capabilities in relation to at least one of the following: time slot configuration, modulation type, bit rate, and capability class, to said system in order to enable the system to deduce on the basis of the informed data whether the terminal is capable of receiving the service or not (see fig.1 step 15-18, col. 1 lines 15-17, col. 5 lines 45-55, col. 6 line 30-col. 7 line 10, and col. 9 lines 1-15).

Regarding claims 16, and 48, Lupien discloses characterized in that it further comprises a step wherein the system either accepts or rejects the terminal's join request based on said deduction (col. 5 lines 45-56, and col. 6 lines 1-3).

Regarding claims 19, Lupien discloses the method of claim 15, characterized in that said informed data indicates at least one of the following features supported by said terminal: time slot configuration, modulation type, bit rate, and capability class (see tables 1-2 and col. 5 lines 45-56).

Regarding claims 20, Lupien discloses the method of claim 15, characterized in that it further comprises a step wherein the service-related data is transmitted in conformity with indicated requirements (see table 2-3, col. 7 lines 15-20, and col. 9 lines 1-5).

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 17-18, 21-22, 31-32, and 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien in view of US Pub. 2002/0071480 A1 to Marjelund.

Regarding claims 17-18, 21-22, 31-32, and 49-50, Lupien discloses method above, however, Lupien fails to specifically disclose characterized in that said system is substantially GSM GPRS or UMTS system, characterized in that said informing is performed over a radio access network that is substantially GERAN or UTRAN, and characterized in that said point-to-multipoint service is substantially a multicast service, characterized in that the air interface in said system is substantially in accordance WLAN specifications. Marjelund disclose characterized in that said system is substantially GSM GPRS or UMTS system, characterized in that said informing is performed over a radio access network that is substantially GERAN or UTRAN, and characterized in that said point-to-multipoint service is substantially a multicast service, characterized in that the air interface in said system is substantially in accordance WLAN specifications (see fig. 1, the use multicast service and WLAN are well known in the art). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the invention of Lupien in the system of Marjelund for the purpose of meeting with the user's preference.

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the state of the art with respect invention:

U.S. Pat. No. 5924026 to Krishnan

U.S. Pat. No. 5940759 to Lopez-Torres et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EMEM STEPHEN whose telephone number is 571 272 8129. The examiner can normally be reached on 8-5 Mon-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on 571 272 7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
LESTER G. KINCAID  
SUPERVISORY PRIORITY EXAMINER



Application/Control Number:

10/529,705

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A handwritten signature in black ink, appearing to read "Mr. Stephen".

ES

12/06/2007

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